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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/024,923      | 02/17/98    | KIKINIS              | P3295               |

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EXAMINER

KWOH, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2733     | 5            |

DATE MAILED: 07/06/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/024,923

Applicant(s)  
KIKINIS

Examiner  
Jasper Kwoh

Group Art Unit  
2733



☒ Responsive to communication(s) filed on Feb 1, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Feb 17, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Drawings*

1. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the IVR for negotiation, look-up table for retrieving specific data, and converting between two like networks such as DNT to DNT must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

### *Claim Objections*

3. Claims 1-6 and 13-17 are objected to because of the following informalities: Claims 1 and 13 are apparatus claims claiming as a limitation control routines which are not physical elements. It is unclear how a way to perform a function is related to the physical description of the bridge unit. Claim 13 uses the phrase "adapted for." It has been held that the recitation that an element is adapted for performing a function is not a positive element but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe in such full, clear, exact and concise terms as to the situation of the networks both being connection-oriented or DNT networks because it is known to any person skilled in the art that the bridge can not function the same way when the protocols are changed that drastically.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 5 recites the limitation "code routines" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is unclear if the applicant is referring to the control routines or some other routines.

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***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-4, 7-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Williams et al.

Regarding claims 1 and 13, Williams et al. discloses bridge unit comprising: a trunk-line port for receiving and placing COST calls (i.e. 14, 15); a data network port for receiving and placing DNT calls; conversion circuitry (i.e. 15); control routines wherein a first call is dynamically converted and placed on the other network (i.e. col. 5, ll. 15-25).

Regarding claim 7, Williams et al. discloses a method for converting calls comprising: connecting a COST trunk line to a trunk-line port (i.e. 14, 15); connecting a data network line to a data network port (i.e. 15, 16); receiving a first call (i.e. fig. 1A); placing a second call (i.e. 1B); and dynamically convert data (i.e. col. 5, ll. 15-25).

Regarding claims 2, 8 and 14-15, Williams et al. disclose the first network being a PSTN (i.e. 11-14) and the second the internet (i.e. 10).

Regarding claims 3-4 and 9-10, Williams et al. disclose retrieving IP address and accessing a look-up table to place a call (i.e. figs. 6, 7).

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***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 5-6 and 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Iwami et al.

Williams et al. do not specifically disclose negotiating with the caller to ascertain the number using an interactive voice response unit (IVR). However, Iwami et al. teach the use of IVR (i.e. fig. 5) in a voice communication system to obtain the desired address or phone number (i.e. abstract). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include an IVR to audibly receive the desired information as taught by Iwami et al. with the system and method of Williams et al. in order to provide customers with greater ease and friendlier atmosphere when placing a call.

***Response to Arguments***

13. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a.Rashman et al. is cited for assigning a digital communication data stream across a cell network.

b.Baran et al. is cited to show synchronous packet voice/data communication system.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasper Kwoh whose telephone number is (703) 305-0101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached on (703) 305-4729.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

16. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-3988 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Jasper Kwoh



June 29, 2000



HUY D. VU  
PRIMARY EXAMINER